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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/657,535 | 09/08/2003 | Joseph Kochansky | (49357) 59004 | 9877 |
| 7590 Edwards & Angell, LLP P.O. Box 9169 Boston, MA 02209 | | | EXAMINER BARTLEY, KENNETH | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,535

Applicant(s)

KOCHANSKY, JOSEPH

Examiner

Kenneth L. Bartley

Art Unit

3693

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/09/2004
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 have been examined.

Specification

2. The disclosure is objected to because of the following informalities: page 4, line 15 has a superfluous "the" in the sentence "...the each compliance...".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1, for example, recites providing compliance rules and applying a set of compliance rules to determine a transaction limit, but the claim does not produce useful, concrete and tangible results (MPEP 2016 IV C 2). There is no subsequent step from the two steps provided, such as a step where the proposed transaction is accepted or rejected. In other words, the process, method and product recited in the respective claims do not meet the statutory definition of a process, method or product.

Independent claims 8 and 15 have similar problems. Claims 2-7, 9-14, 16-21 are rejected because they depend from their respective independent claims.

Specifically, regarding process and method claims, the Court has held that the "transformation and reduction of an article to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines. *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. Jul. 23, 1998).

The instant claims do not meet this standard of a statutory definition of a process claim. Therefore, it is concluded that the subject claims are not directed to a statutory matter under 35 USC 101 since (i) they are not patentable as process claims and (ii) they do not produce useful, concrete, and tangible results.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 has the step of "applying the set of compliance rules to a proposed transaction to determine a transaction limit therefor." It is unclear how a transaction limit is determined by just applying compliance rules. For example, a transaction limit could be calculated based on a compliance rule (as in claim 2).

8. Claims 22 and 25 have the step "sorting each applicable compliance rule..." but it is unclear what the purpose of this is. For example, is the sorted information reported and used with the proposed transaction to evaluate the most restrictive rules?

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9. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the preamble to the claims promise "...determining the buying power of an investment portfolio" but there is no step where this is accomplished.

10. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: there is no means for determining the buying power of an investment portfolio.

11. Claims 2-7, 9-14, 16-21, 23-24 and 26-27 are rejected because they depend from their respective independent claims.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2, 5, 8-9, 12, 15-16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,893,079 to Cwenar.

[Note that the analysis for the method claims (8-14 and 22-24) also applies to their respective system claims (15-21 and 25-27).]

Regarding claim 1:

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(claim 1) A method of determining the buying power of an investment portfolio, the method comprising the steps of:

a) providing a set of compliance rules for an investment portfolio; and

Cwenar provides:

"The system is particularly suited for use with mutual fund portfolio management and transactional information." (Abstract)

Compliance rules for investment portfolios...

"The system further provides, in preferred forms, the use of relational databases and central data repository, the use of dynamically linked library architecture with firewalls, rules-based compliance systems and great flexibility in respect of storage and communication of investment information." (col. 14, lines 10-15)

b) applying the set of compliance rules to a proposed transaction to determine a transaction limit therefor.

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 2, lines 66-67 and col. 3, lines 1-2)

Regarding claim 2:

A method according to Claim 1, further comprising the step of calculating the transaction limit for the proposed transaction for each compliance rule in the set of compliance rules.

Cwenar provides:

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 5, lines 22-26). For a transaction not to violate predetermined rules requires calculation of a transaction limit.

Regarding claim 5:

A method according to Claim 1, further comprising the step of determining whether each compliance rule in the set of compliance rules applies to the proposed transaction.

Cwenar provides:

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 2, lines 66-67 and col. 3, lines 1-2) To accomplish this requires using rules that apply to a proposed transaction.

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Regarding claims 8 and 15:

(claim 8) A method of determining the buying power of an investment portfolio comprising the steps of:

a) providing a set of compliance rules for an investment portfolio;

Cwenar provides:

"The system is particularly suited for use with mutual fund portfolio management and transactional information." (Abstract)

Compliance rules for investment portfolios...

"The system further provides, in preferred forms, the use of relational databases and central data repository, the use of dynamically linked library architecture with firewalls, rules-based compliance systems and great flexibility in respect of storage and communication of investment information." (col. 14, lines 10-15)

b) receiving a request to analyze a proposed transaction; and

"The preference rules 168 may take the form of certain business preferences imposed by the portfolio manager of the mutual fund, such as legally permissible transactions which, from a business standpoint, the manager of the mutual fund does not desire to enter." (col. 12, lines 36-40)
Therefore, the portfolio manager is requesting the system to analyze a proposed transaction, where such system must then receive a request.

c) calculating a transaction limit for the proposed transaction based upon the set of compliance rules.

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 5, lines 22-26). For a transaction not to violate predetermined rules requires calculation of a transaction limit.

Regarding claims 9 and 16:

(claim 9) A method according to Claim 8, wherein the step of calculating a transaction limit includes calculating a transaction limit for each compliance rule in the set of compliance rules.

Cwenar provides:

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 2, lines 66-67 and col. 3, lines 1-2) Not to violate the plural rules requires evaluation of each rule to transaction limits.

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Regarding claims 12 and 19:

(claim 12) A method according to Claim 8, further comprising the step of determining whether each compliance rule in the set of compliance rules applies to the proposed transaction.

Cwenar provides:

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 2, lines 66-67 and col. 3, lines 1-2) To accomplish this requires using rules that apply to a proposed transaction.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 6-7, 13-14, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,893,079 to Cwenar in view of Pub. No. US 2004/0220872 to Pollock, III.

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Regarding claim 6:

A method according to Claim 5, wherein the step of determining whether the each compliance rule applies to the proposed transaction includes testing each compliance rule against the proposed transaction using a nominal transaction value.

While Cwenar teaches applying compliance rules to a proposed transaction, he does not teach using a nominal transaction value.

Pollock, III also in the business of compliance rules teaches:

"... the invention features a method that includes receiving a proposed nominal value of an appreciation loan associated with an appreciating asset, and determining whether the nominal value meets guidelines of a lender of the loan."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add a test for nominal value, motivated by Pollock, III, and that doing this would be an added proposed transaction that would easy to carry out by Cwenar's system.

Regarding claim 7:

A method according to Claim 6, further comprising the step of determining that the buying power of the portfolio for the proposed transaction is zero if the nominal transaction value for the proposed transaction violates a compliance rule.

It is inherent in compliance rule testing that if the test fails, a proposed transaction would not occur, and therefore the value of the proposed transaction would be zero.

Regarding claims 13 and 20:

(claim 13) A method according to Claim 12, wherein the step of determining whether the each compliance rule in the set of compliance rules applies to the proposed transaction includes testing each compliance rule against the proposed transaction using a nominal transaction value.

While Cwenar teaches applying compliance rules to a proposed transaction, he does not teach using a nominal transaction value.

Pollock, III also in the business of compliance rules teaches:

"... the invention features a method that includes receiving a proposed nominal value of an appreciation loan associated with an appreciating asset, and determining whether the nominal value meets guidelines of a lender of the loan."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add a test for nominal value, motivated by Pollock, III, and that doing this would be an added proposed transaction that would easy to carry out by Cwenar's system.

Regarding claims 14 and 21:

(claim 14) A method according to Claim 13, further comprising the step of determining

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that the buying power of the portfolio for the proposed transaction is zero if the nominal transaction value for the proposed transaction violates a compliance rule.

It is inherent in compliance rule testing that if the test fails, a proposed transaction would not occur, and therefore the value of the proposed transaction would be zero.

17. Claims 3-4, 10-11, 17-18, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,893,079 to Cwenar in view of Official Notice.

Regarding claim 3:

A method according to Claim 2, further comprising the step of sorting the compliance rules from most restrictive to least restrictive based upon the transaction limit calculated for each compliance rule.

Cwenar teaches:

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46)

While Cwenar discloses prioritizing compliance rules, he does not disclose sorting the rules from least to most restrictive based on transaction limits. However, the Examiner takes Official Notice that sorting information based on relevancy is old and well known. Therefore, it would have been obvious to one skilled in the art at the time of invention to include the ability to sort compliance rules from most to the least restrictive and that doing this would permit quick assessment of the most critical rules that are gating a transaction.

Regarding claim 4:

A method according Claim 3, further comprising the step of determining the buying power of the portfolio based upon the transaction limit associated with the most restrictive compliance rule.

Cwenar provides:

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46) Therefore, prioritized rules are available, and a proposed trade is compared against them. It would be inherent that a trade would be gated by the most restrictive rule.

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Regarding claims 10 and 17:

(claim 10) A method according to Claim 9, further comprising the step of sorting the compliance rules from most restrictive to least restrictive based upon the transaction limit calculated for each compliance rule.

Cwenar teaches:

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46)

While Cwenar discloses prioritizing compliance rules, he does not disclose sorting the rules from least to most restrictive based on transaction limits. However, the Examiner takes Official Notice that sorting information based on relevancy is old and well known. Therefore, it would have been obvious to one skilled in the art at the time of invention to include the ability to sort compliance rules from most to the least restrictive and that doing this would permit quick assessment of the most relevant rules that are gating a transaction.

Regarding claims 11 and 18:

(claim 11) A method according Claim 10, further comprising the step of determining the buying power of the portfolio based upon the transaction limit associated with the most restrictive compliance rule.

Cwenar provides:

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46) Therefore, prioritized rules are available, and a proposed trade is compared against them. It would be inherent that a trade would be gated by the most restrictive rule.

Regarding claims 22 and 25:

(claim 22) A method of determining the buying power of an investment portfolio comprising the steps of:

a) receiving a request to analyze a proposed transaction involving a security from a portfolio manager for a selected portfolio stored in a portfolio database;

Cwenar discloses:

"The preference rules 168 may take the form of certain business preferences imposed by the portfolio manager of the mutual fund, such as

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legally permissible transactions which, from a business standpoint, the manager of the mutual fund does not desire to enter." (col. 12, lines 36-40) Therefore, the portfolio manager is requesting the system to analyze a proposed transaction, where such system must then receive a request:

b) retrieving the selected portfolio from the portfolio database;

Ability to access portfolio information (in this case a mutual fund)...

"If a user 22, 24, 26, 28 acting through the external user interface 2 desires to access within server means 4, information such as what companies are held by mutual fund XYZ, information from column A of the relational database would be provided." (col. 9, lines 30-34)

c) accessing a set of compliance rules related to the selected portfolio from a rules database;

"The compliance check may be performed on both the external user interface and the server employing rules stored in the main database." (col. 2, lines 46-48)

d) determining whether each compliance rule in the set of compliance rules related to the selected portfolio applies to the proposed transaction;

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46)

e) calculating a transaction limit for the proposed transaction for each applicable compliance rule in the set of compliance rules;

"It is another object of the present invention to provide such a system which permits real-time, rule-based compliance review in order to determine that a proposed transaction will not violate predetermined rules." (col. 2, lines 66-67 and col. 3, lines 1-2)

f) sorting each applicable compliance rule from most restrictive to least restrictive; and **Cwenar teaches:**

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46)

While Cwenar discloses prioritizing compliance rules, he does not disclose sorting the rules from least to most restrictive based on transaction limits. However, the Examiner takes Official Notice that sorting information based

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on relevancy is old and well known. Therefore, it would have been obvious to one skilled in the art at the time of invention to include the ability to sort compliance rules from most to the least restrictive and that doing this would permit quick assessment of the most relevant rules that are gating a transaction.

g) specifying the buying power of the selected portfolio for the proposed transaction based on the transaction limit for the most restrictive of the applicable compliance rules.

Cwenar provides:

"The system also provides compliance means which serves to on a real-time basis compare a proposed trade with a group of rules which can be prioritized with respect to legal or business standards and provide instructions regarding stopping, delaying or proceeding with the proposed trade with appropriate records being kept." (col. 2, lines 41-46) Therefore, prioritized rules are available, and a proposed trade is compared against them. It would be inherent that a trade would be gated by the most restrictive rule.

18. Claims 23-24, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over section (17) above in further view of Pub. No. US 2004/0220872 to Pollock, III.

Regarding claims 23 and 26:

(claim 23) A method according to Claim 22, wherein the step of determining whether each compliance rule in the set of compliance rules applies to the proposed transaction includes testing each compliance rule against the proposed transaction using a nominal transaction value.

While Cwenar teaches applying compliance rules to a proposed transaction, he does not teach using a nominal transaction value.

Pollock, III also in the business of compliance rules teaches:

"... the invention features a method that includes receiving a proposed nominal value of an appreciation loan associated with an appreciating asset, and determining whether the nominal value meets guidelines of a lender of the loan."

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add a test for nominal value, motivated by Pollock, III, and that doing this would be an added proposed transaction that would easy to carry out by Cwenar's system.

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Regarding claims 24 and 27:

(claim 24) A method according to Claim 23, further comprising the step of determining that the buying power of the selected portfolio for the proposed transaction is zero if the nominal transaction value violates a compliance rule related to the selected portfolio.

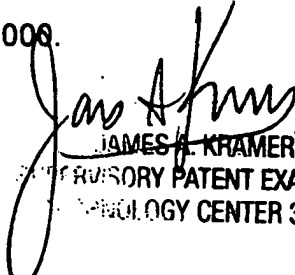
It is inherent that if a proposed transaction fails a compliance rule, a transaction will not occur.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth L. Bartley whose telephone number is (571) 272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 10.23.07
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